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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,747	08/28/2001	Shelby Freland Thames	TH1802 (US)	5763
7590	11/03/2003		EXAMINER	
Donald F. Haas Shell Oil Company Legal-Intellectual Property P.O. Box 2463 Houston, TX 77252-2463			SHORT, PATRICIA A	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/940,747	Applicant(s) THAMES ET AL.	
	Examiner Patricia A. Short	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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This action is in response to the request for continued examination (RCE) and amendment filed on September 5, 2003.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10, 12, 13 and 15-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear whether the 85 to 96 wt% and 4 to 25 wt% are based upon the powder coating composition or the combination of polyester resin and triglycidyl isocyanurate crosslinking agent. It appears from the specification that the percentages are based upon the combination of polyester resin and triglycidyl isocyanurate crosslinking agent. See examples PT-15 and PT-30 where additives are used in amounts that result in composition in which the polyester is not within the range of 85 to 96 wt% based upon the powder coating composition.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 12-20, 22-29 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merck. The rejection is applied as in the Office Action mailed September 25, 2002. Applicant argues that the reference does not suggest the amounts of 1,3-propanediol, polyester and triglycidyl isocyanurate required in the claims. If the amounts of polyester and

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triglycidyl isocyanurate are based upon the combination of polyester and triglycidyl isocyanurate, then the amounts used in Example 6 of the reference are within the claimed range. If the amounts are based upon the powder coating composition, then it would have been obvious to exclude the optional components used in Example 6 resulting in a powder coating containing polyester and triglycidyl isocyanurate in the amounts required in the claims. At col. 3, lines 34-46, 1, 3-propanediol is specified as one of ten possible glycols that also include neopentyl glycol in preferred amounts of more than 50 mol%. The polyesters used in the examples are prepared from neopentyl glycol in amounts of more than 50 mol% with ethylene glycol, another of the exemplified glycols, in amounts of more than 5 mol%. Thus, the reference suggests copolyesters prepared from more than 50 mol% of neopentyl glycol with other glycols that include 1,3-propanediol in amounts of more than 5 mol%.

Applicant further argues that criticality for the ranges of 5 to 90% and 15 to 50% of 1,3-propanediol have been demonstrated. With respect to the 5 to 90% range, there is no evidence relating to polyesters having an amount of 5 mol% of 1,3-propanediol. With respect to the 15 to 50% range, there is no comparison with the closest prior art, i.e. the neopentyl/ethylene glycol polyester compositions of the reference and there is no showing commensurate in scope with the claims.

Claims 1-3, 5-10, 12-15, 17-24 and 26-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsiat. The rejection is applied as in the Office Action mailed September 25, 2002. Applicant argues that the reference does not suggest the amounts of 1,3-propanediol, polyester and triglycidyl isocyanurate required in the claims. If the amounts of polyester and triglycidyl isocyanurate are based upon the combination of polyester and triglycidyl isocyanurate, then the amounts used in the examples of the reference are within the claimed range. If the amounts are based upon the powder coating composition, then it would have been obvious to exclude the optional components used in the examples resulting in a powder coating containing

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polyester and triglycidyl isocyanurate in the amounts required in the claims. At col. 3, lines 52-55, 1, 3-propanediol is specified as one of eight possible glycols that also include neopentyl glycol. The polyesters used in the examples are prepared from neopentyl glycol in amounts of more than 50 mol% with ethylene glycol, another of the exemplified glycols, in amounts of more than 5 mol%. Thus, the reference suggests copolyesters prepared from more than 50 mol% of neopentyl glycol with other glycols that include 1,3-propanediol in amounts of more than 5 mol%.

Applicant further argues that criticality for the ranges of 5 to 90% and 15 to 50% of 1,3-propanediol have been demonstrated. With respect to the 5 to 90% range, there is no evidence relating to polyesters having an amount of 5 mol% of 1,3-propanediol. With respect to the 15 to 50% range, there is no comparison with the closest prior art, i.e. the neopentyl/ethylene glycol polyester compositions of the reference and there is no showing commensurate in scope with the claims.

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

P. Short

October 23, 2003

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PATRICIA A. SHORT
PRIMARY EXAMINER

